

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HELMUT HONIG, GEORG PAMPOUCHIDIS,  
WILLIBALD PAAR, HERBERT MATZER and  
MANFRED VALTROVIC

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Appeal No. 95-2008  
Application No. 08/032,178<sup>1</sup>

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HEARD: November 4, 1998

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Before GARRIS, WARREN, and WALTZ, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 13 through 21, which are the only claims remaining in this application.

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<sup>1</sup> Application for patent filed March 15, 1993. According to applicants, this application is a continuation of Application 07/739,854, filed August 2, 1991; now abandoned.

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According to appellants, the invention is directed to an improvement over commonly assigned U.S. Patent No. 4,968,730 (hereafter "Honig") wherein the quaternization of the tertiary amines in the final pigment paste as required by Honig is unnecessary if the epoxide resin starting materials contain a sufficient number of polyoxyalkylene structures (brief, pages 2-3). Claim 13 is illustrative of the subject matter on appeal and is attached as an Appendix to this decision.

The examiner relies upon the following references as evidence of obviousness:

Paar et al. (Paar)	4,683,285	Jul. 28, 1987
Anderson et al. (Anderson)	4,698,141	Oct. 6, 1987

Claims 13 through 21 stand rejected under 35 U.S.C. § 103 as unpatentable over Paar in view of Anderson (answer, page 3). We reverse this rejection for reasons which follow.

#### OPINION

The process of appealed claim 13 requires a starting material reactant which is a diepoxide compound with the schematic structure "Z-Y-X-Y-Z" containing, *inter alia*, 10 to 50% by weight of polyoxyalkylene structures and possessing a

glass transition temperature between 10 and 40EC. (see part (A) of claim 13).

Appellants submit that the applied prior art references do not disclose or suggest the diepoxide reactant of part (A) in claim 13 (brief, page 6, first full paragraph, and pages 7-8). Contrary to the examiner's assertion on page 3 of the answer, appellants do dispute that Anderson discloses the "epoxy resin component '(A)'" (see the brief, page 8, last paragraph, and the reply brief, pages 1-2). The examiner has not pointed out, and we cannot perceive, any disclosure where the epoxy resin starting material of appealed claim 13 is found in either Paar or Anderson or where any suggestion can be found to modify or alter the epoxy resins of Paar or Anderson to produce the required epoxy resin recited in appealed claim 13, part (A). *See In re Ochiai*, 71 F.3d 1565, 1569-70, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995). The examiner, on page 3 of the answer, refers to the Office action of Paper No. 11 (dated May 17, 1993) for an explanation of the rejection. We fail to find any citation to Paar or Anderson in the Office action of Paper No. 11 which would

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disclose or suggest the specific epoxy resin starting materials of appealed claim 13, part (A).

The applied prior art references contain nothing to support the examiner's conclusion that the particular process of appealed claim 13 would have been obvious. See *In re Ochiai, supra*. For the foregoing reasons, we conclude that the examiner has failed to establish a *prima facie* case of obviousness.

Accordingly, the rejection of claims 13 through 21 under 35 U.S.C. § 103 as unpatentable over Paar in view of Anderson is reversed.

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*REVERSED*

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES F. WARREN	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
THOMAS A. WALTZ	)	
Administrative Patent Judge	)	

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APPENDIX

13. Process for the preparation of pigment paste resins for cathodically depositable coating compositions, comprising reacting -

(A) at least one diepoxide compound which has the schematic structure -



wherein X is the moiety of an aliphatic diepoxy resin which has polyoxyalkylene structures and which remains after reacting the epoxy groups, Y is the moiety of a primary (hydroxy)alkylmonoamine or a secondary (polyoxy)alkylenediamine or a diphenol, and Z is the moiety of an epichlorohydrin-bisphenol A-epoxy resin, which contain(s), based on the total weight of the diepoxide compound 10 to 50% by weight of polyoxyalkylene structures, and up to 20% by weight of alkyl or alkylene or hydroxyalkyl radicals with more than 3 carbon atoms, and has a glass transition temperature between 10 and 40°C, with

(B) 50 to 100 mol%, based on the epoxide groups in (A), of a primary-tertiary diamine and, thereafter,

(C) reacting 50 to 100 mol% of formaldehyde, based on the total of the primary amino groups of the amines used in (B), with the reaction product of (B) to form oxazolidine structures, said process being completed without quaternization.

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APJ WARREN

APJ GARRIS

DECISION: REVERSED  
Send Reference(s): Yes No  
or Translation (s)  
Panel Change: Yes No  
Index Sheet-2901 Rejection(s): \_\_\_\_\_

Prepared: July 14, 1999

Draft      Final

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OB/HD      GAU

PALM / ACTS2 / BOOK  
DISK (FOIA) / REPORT